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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/689,721 08/12/96 PERRY

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EXAMINER

MMC2/0620

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ART UNIT

PAPER NUMBER

2833

DATE MAILED:

06/20/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/689,721

Applicant(s)

Perry

Examiner

Renee S. Luebke

Group Art Unit

2833



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 11-13 is/are pending in the application.

Of the above, claim(s) none is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 11-13 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. The Office actions of November 18, 1999 and January 27, 2000 are hereby withdrawn.
2. The request filed on October 12, 1999 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/689721 is acceptable and a CPA has been established. An action on the CPA follows. This action also takes into consideration the amendment filed May 5, 2000.
3. The amendment filed October 12, 1999 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is the order of the method steps that requires the strap to be placed on the neck of the user and then the recorder to be pulled apart and placed in the ring. Applicant is required to cancel the new matter in the reply to this Office action.
4. Claims 11-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The original specification did not suggest that the ring be placed on the recorder after the strap was placed around the neck of the user.
5. Claims 11-13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for pulling the recorder apart and then placing the

ring thereon, does not reasonably provide enablement for performing this operation *after* the strap has been placed on the neck of the user. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to perform the method of the invention commensurate in scope with this claim. The order of the assembly is critical and essential to the practice of the invention, since it is included in the claims, but is not enabled by the disclosure.

6. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 13 is the same as claim 11 and will not be allowed in view thereof.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Thompson shows a typical recorder which is not usable with the present invention since it does not have a diameter that increases from the juncture toward the mouthpiece.

8. **Any response to this action may be mailed to:**

Assistant Commissioner for Patents  
Washington, DC 20231

**or faxed to:**

(703) 308-7722 or 308-7724 or 308-7328  
(informal or draft communications should be clearly labeled "PROPOSED"  
or "DRAFT")

**Hand-delivered responses** should be brought to:

Crystal Plaza 4, Fourth Floor (Receptionist)  
2201 South Clark Place, Arlington, Virginia.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mrs. Renee Luebke at (703) 308-1511. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mrs. Paula Bradley, can be reached at (703) 308-2319.



Renee S. Luebke  
Primary Patent Examiner  
June 15, 2000